

(c) REMARKS

Applicants do not wish to have the (unentered) Amendment filed August 17, 2007 entered into the filewrapper and request that the reply of August 17, 2007 specifically not be entered. The present Amendment is in response to the outstanding final action. The claims are 1, 2, 4 and 18-36 with claims 1, 18, 24, 25 and 26 being independent. Claim 1 has been amended to include the subject matter of claim 3 to better define the claimed invention.

The Examiner rejected claims 1-4 and 18-36 as an obviousness type double patenting over claims 1-16 of Honma '743. The Examiner argues units of Formula (1) and (2) of Honma '743 have a R₁ containing a phenyl residue which is said to be substantially the same as applicants' Formula (3) in claim 1. In addition, when Formula (12) or Formula (13) in claim 2 of Honma '743 is substituted for R₃ in claim 2 in Honma '743 they became identical to units of Formula (1) and (2) of instant claim 1. Claims 1-14 and 18 were also rejected as anticipated by Honma '743. The rejection is respectfully traversed.

Honma '743 requires the presence of Formula (1) which is a 3-hydroxy- ω -(4-vinylphenyl) alkanoate unit. The vinyl group is substituted on the phenyl ring at the 4-(or the para-) position. Indeed, the Examiner notes on page 5, first two paragraphs of the outstanding Official Action that because the present claim 1 recites R_z is phenyl, that the 4-vinyl phenyl structure of Honma meets that limitation.

Present claim 1 has now been amended to specifically exclude a 4-vinyl substituent on the phenyl residue pursuant to formula (8) in former claim 3. Therefore, there is no overlap or claim conflict, nor is there any anticipation based on Honma '743.

Claims 1-4 and 18-36 were provisionally rejected as an obviousness type double patenting over claims 1-6 and 12-40 of pending Application No. 10/532,226, now U.S. Patent Publication No. 2006/0079662A1. In particular, the Examiner argues that in Formula (3) of present claim 1 when R_z is phenyl, this includes claim 1 of the ‘226 Application. Claim 1 of the ‘226 Application is a COOR’ substituted phenyl residue, where R₁ is H, Na or K. This residue has been specifically excluded from the present claims. Therefore, there can be no conflict between the claims. One can freely practice the claims of the ‘226 Application without conflicting with the present claims, and vice versa.

Claims 3 and 4 of the ‘226 Application claim a polyhydroxyl alkanoate formed by copolymerizing a unit of chemical formula (1) with either a unit of formula (3) or formula (4). Claim 1 of the ‘226 Application is a homopolymer of only repeating units of formula (1). On the other hand, claims 3 and 4 claim a different polyhydroxyalkanoate than in claim 1. The polymer of claims 3 or 4 is a copolymer formed of two different repeating units. For example, the homopolymer of claim 1 is a chain of the same repeating units, (i.e. -(1) -(1) -(1) -(1) -). Claims 3 and 4 claim a copolymer of two different repeating units; (i.e. -(1)-(3) -(1) -(3)- or -(1) -(4) -(1) -(4)). “Copolymers” are different in kind from “homopolymers” and are distinct from them. For example, a poly(styrene) homopolymer is distinct from a copolymer of poly(styrene-methacrylic acid).

If any issues remain, the Examiner is requested to contact the undersigned to resolve them. The amendment should be entered, the claims allowed and the case passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

/Peter Saxon/

Peter Saxon
Attorney for Applicants
Registration No.: 24,947

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

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